

### **Remarks**

The above Amendments and these Remarks are in reply to the Office Action mailed July 6, 2001. Claims 15-21, 23 and 27-46 were pending in the Application prior to the outstanding Office Action. In the Office Action, claims 15-21, 23 and 27-46 were rejected under 35 U.S.C. § 112, second paragraph. Claims 15, 17, 19-20, 23, 27-28, 30, 34, 37, 40-41 and 43 were rejected 35 U.S.C. § 102 (b). Claims 15-21, 27-40 and 42-46 were rejected under 35 U.S.C. § 103 (a). Applicants will address each basis of rejection in sequence.

#### **I. RESPONSE TO REJECTIONS UNDER 35 U.S.C. § 112, SECOND PARAGRAPH**

On page 3 of the Office Action mailed July 6, 2001 the Examiner rejected claims 15-21, 23 and 27-46 under 35 U.S.C. § 112, second paragraph.

##### **A. Independent Claim 15**

Applicants have amended claim 15 to clarify that the continuous loop is formed by interlocking the first and second holder engaging mechanisms of adjacent holders. Applicants respectfully suggest that amended claim 15 completely sets forth an operative device and distinctly claims the subject matter which applicants regard as the invention. Therefore, Applicants respectfully request that this rejection be removed.

##### **B. Dependent Claims 16-21, 23**

Applicants have amended claim 16 to clarify that each wall has at least one projecting member to retain said object. Therefore, applicants respectfully suggest that amended claim 16 distinctly claims the subject matter of the invention.

Dependent claims 17-19 and 23 depend ultimately from independent claim 15. These dependent claims include all of the limitations of the independent claim from which it depends. Applicants respectfully

request that dependent claims 17-19, 23 be allowed for at least the reasons set forth above from independent claim 15.

Applicants have amended claim 20 to correct a typographical error. Claim 20 has been amended to depend from claim 19.

Applicants have amended claim 21 to clarify that the “rib member” and “projecting member” retain a portion of a first and second object.

**C. Claims 27-36**

Claims 27-36 have been cancelled. Therefore, no response is due and Applicants respectfully request that this rejection be removed.

**D. Independent Claim 37**

According to Section 2185 of the Manual of Patent Examination Procedure (MPEP), a rejection under 35 U.S.C. § 112, second paragraph is appropriate only “if a means or step plus function limitation recited in a claim is not supported by corresponding structure material or acts in the specification disclosure.” MPEP §2185. Applicants respectfully suggest that the invention disclosed in claim 37 is properly supported in the originally filed patent application. By way of example only, an embodiment of the “means for matingly interlocking adjacent holders to each other to form said continuous loop” is disclosed on p. 7, line 31 through p. 11, line 14. Therefore, Applicants respectfully suggest that claim 37 satisfies the requirements of 35 U.S.C. § 112, second paragraph.

**E. Dependent Claims 38-46**

Dependent claims 38-45 depend ultimately from independent claim 37. These dependent claims

include all of the limitations of the independent claim from which it depends. Applicants respectfully request that dependent claims 38-45 be allowed for at least the reasons set forth above from independent claim 37. Claim 46 has been cancelled.

## **II. RESPONSE TO REJECTIONS UNDER 35 U.S.C. § 102(b)**

### **1. Deutsche Patent No. DE9313107**

On page 4 of the Office Action mailed July 6, 2001 the Examiner rejected claims 15, 17, 19-20, 27-28, 30, 34, 37, 40 and 43 under 35 U.S.C. § 102(b) as being anticipated by Deutsche Patent No. DE9313107 ("*Deutsche*").

#### **A. Independent Claim 15**

With regard to amended claim 15, *Deutsche* does not disclose interlocking adjacent holders such that the "second holder-engaging mechanism of each said holder is adapted to be seated in a groove between adjacent teeth on a sprocket." *Deutsche* discloses a base 20 having a first coupling mechanism 21 and a second coupling mechanism 23. The first coupling mechanism 21 interlocks with the second coupling mechanism 23 of an adjacent holder to form a continuous loop. As shown in Fig. 5 of *Deutsche*, the coupling created between adjacent holders never contacts wheel 5 or wheel 7. Only the base 20 contacts the wheels 5, 7. In fact, it is not possible for the coupling to be seated in a groove between adjacent teeth on a sprocket because the wheels 5, 7 in *Deutsche* have smooth surfaces. Therefore, claim 15 is not anticipated by *Deutsche*.

#### **B. Dependent Claims 17, 19-20**

Dependent claims 17, 19-20 depend ultimately from independent claim 15. These dependent claims

include all of the limitations of the independent claim from which it depends. Applicants respectfully request that dependent claims 17, 19-20 be allowed for at least the reasons set forth above from independent claim 15.

**C. Claims 27-28, 30 and 34**

Claims 27-28, 30 and 34 have been cancelled. Therefore, no response is required and Applicants respectfully request that this rejection be removed.

**D. Independent Claim 37**

With regard to amended claim 37, *Deutsche* does not disclose a base having a male and female coupling mechanism located on an inward surface of the base. In contrast, *Deutsche* discloses a base 20 whereby the male coupling mechanism 23 and the female coupling mechanism 21 are located on opposite ends of the base 20. *Deutsche*, Figs. 6, 7b. The holder disclosed by the present invention is an improvement over *Deutsche*. The female and male coupling mechanisms are located on the same surface of the base facing the wheel. This structure allows each holder to make a tighter radius turn around the wheel, promoting a greater fan-out of the holders as they pass the turnaround region. Therefore, claim 37 is not anticipated by *Deutsche*.

**E. Dependent Claims 40, 43**

Dependent claims 40, 43 depend ultimately from independent claim 37. These dependent claims include all of the limitations of the independent claim from which it depends. Applicants respectfully request that dependent claims 40, 43 be allowed for at least the reasons set forth above from independent claim 37.

## **2. U.S. Patent No. 887,282**

On page 4 of the Office Action mailed July 6, 2001 the Examiner rejected claims 23, 27, 28, 37 and 41 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 887,282 issued to H.C. Smith ("*Smith*").

### **A. Claims 23, 27-28**

Applicants have cancelled claim 23, 27-28. Therefore, no response is required and Applicants respectfully request that this rejection be removed.

### **B. Independent Claim 37**

With regard to amended claim 37, *Smith* does not disclose a holder to "frictionally retain at least a portion of at least one object." *Smith* discloses a casing or compartment for loosely storing articles within. Specifically, *Smith* discloses that the casing or compartment is "a flat rectangular box 22 having a front hinged lid 23." *Smith*, p.1, lines 102-103. Small articles such as medicines or paper can be stored within each holder 22. None of these items are frictionally retained within the rectangular box. Therefore, claim 37 is not anticipated by *Smith*.

### **C. Dependent Claim 41**

Dependent claim 41 depend ultimately from independent claim 37. These dependent claims include all of the limitations of the independent claim from which it depends. Applicants respectfully request that dependent claim 41 be allowed for at least the reasons set forth above from independent claim 37.

### III. RESPONSE TO REJECTIONS UNDER 35 U.S.C. § 103(a)

On page 5 of the Office Action mailed July 6, 2001 the Examiner rejected claims 15-21, 27-40, and 42-46 under 35 U.S.C. § 103(a) as being unpatentable over Deutsche Patent No. DE9313107 ("*Deutsche*"), in view of U.S. Patent No. 5,464,091 issued to Callahan et al. ("*Callahan*").

#### A. Independent Claim 15

With regard to amended claim 15, *Deutsche* does not disclose a loop of inter-connected components where the "second holder-engaging mechanism of each said holder is adapted to be seated in a groove between adjacent teeth on a sprocket." The invention in *Deutsche* discloses a loop of interconnected holders that rotate around a pentagram-shaped wheel 7 located at the top of the device and a smooth, round wheel 5 located at the bottom of the device. *Deutsche*, Fig. 5. Each holder in *Deutsche* has a flat, rectangular base 20. *Deutsche*, Fig. 5. The base 20 engages wheel 7 as the holder rotates around the top of the rack, and engages wheel 5 as the holder rotates around the bottom of the rack. Neither wheel 5 nor wheel 7 have teeth to define a groove that the base 20 can be seated within. Both wheel 5 and wheel 7 have smooth surfaces that the base 20 must rest upon. *Deutsche*, Fig. 5.

The present invention is an improvement over *Deutsche*. The holders in *Deutsche* may slip on the smooth surfaces of wheels 5, 7. Each holder disclosed in the present invention is individually seated within a groove between adjacent teeth on a sprocket. This arrangement promotes engagement of the holder with the sprocket and the fan-out of holders at the turnaround regions. Therefore, claim 15 is not obvious over *Deutsche*.

Moreover, *Callahan* does not disclose that adjacent holders are matingly interlocked to form a continuous loop. *Callahan* teaches a cover 10 to place a diskette 30 into for protecting and storing the diskette 30. Each cover 10 can be interlocked with an adjacent cover 10. However, the connections between

adjacent covers 10 are not flexible and cannot form a loop. Therefore, claim 15 is not obvious over *Deutsche* in view of *Callahan*.

**B. Dependent Claims 16-21**

Dependent claims 16-21 depend ultimately from independent claim 15. These dependent claims include all of the limitations of the independent claim from which it depends. Applicants respectfully request that dependent claims 16-21 be allowed for at least the reasons set forth above from independent claim 15.

**C. Claims 27-36**

Claims 27-36 have been cancelled. Therefore, no response is due and Applicants respectfully request that this rejection be removed.

**D. Independent Claim 37**

With regard to amended claim 37, *Deutsche* does not disclose a base having a male and female coupling mechanism located on an inward surface of the base. In contrast, *Deutsche* discloses a base 20 whereby the male coupling mechanism 23 and the female coupling mechanism 21 are located on opposite ends of the base 20. *Deutsche*, Figs. 6, 7b. The holder of the present invention is an improvement over *Deutsche*. The female and male coupling mechanism are located on the same surface of the base facing the wheel. This structure allows each holder to make a tighter radius turn around the wheel, promoting a greater fan-out of the holders as they pass the turnaround region. Therefore, claim 37 is not obvious over *Deutsche*.

Moreover, *Callahan* does not disclose that a male and female coupling mechanism are located along a common inward surface of the base of each holder. In contrast, *Callahan* discloses that the male and female coupling mechanisms are located on opposite sides of each holder. Specifically, *Callahan* discloses

that “each side 11 includes a dovetail projection 11d near the edge 13, and each side 12 includes a dovetail recess 12r.” *Callahan*, col. 7, lines 51-53. Therefore, claim 37 is not obvious over *Deutsche*, in view of *Callahan*.

**E. Dependent Claims 38-39, 42-46**

Dependent claims 38-39, 42-46 depend ultimately from independent claim 37. These dependent claims include all of the limitations of the independent claim from which it depends. Applicants respectfully request that dependent claims 38-39, 42-46 be allowed for at least the reasons set forth above from independent claim 37.



### Other Remarks

The references cited by the Examiner but not relied upon have been reviewed, but are not believed to render the claims unpatentable, either singly or in combination.

In light of the above, it is respectfully submitted that all of the claims now pending in the subject patent application should be allowable, and a Notice of Allowance is requested. The Examiner is respectfully requested to telephone the undersigned before an advisory action is issued in order to avoid any unnecessary filing of an appeal.

The Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 06-1325 for any matter in connection with this response, including any fee for extension of time, which may be required.

Respectfully submitted,

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## APPENDIX A

As required by 37 C.F.R. §1.121(b)(iii), marked-up copies of the paragraphs of Applicants' Specification amended in this Response are provided below with insertions underlined and deletions bracketed.

**The paragraph which begins on page 7, line 14 has been amended as follows:**

Using appropriate controls, for example knob 37 connected to an electrical switch (not shown) may be used to connect motor 28 windings to DC voltage of a first polarity, an opposite second polarity, to decreased magnitude voltage of either polarity, or to no DC voltage at all. The result is to cause belt rotation in a clockwise direction (e.g., as indicated by arrows 20), in a counter-clockwise direction, to reduce motor rotational speed from high to low, or to halt all movement of the belt by disconnecting operating voltage from motor 28. As shown in Fig. 1, control 37 enables a user to cause belt rotation until the desired object (typically a CD enclosed within a jewel case container 18) reaches the top region 11 of the rack (or tower), at which region (as well as at the bottom most region) the containers fan-out, which facilitates their manual removal from the rack by a human hand. Normally, in the vertical belt regions 13, the containers 18 are retained so closely to one another that their removal from the holders would be difficult. However the fan-out that occurs in turnaround region 11 eases user-removal of a [desired object] container 18 from the rack.

**The paragraph which begins on page 7, line 31 has been amended as follows:**

Racks 10 such as depicted in Figs. 1, 9, and 10 that rotate a linked-together loop 23 formed from holders 32 that retain only a single [object] container 18 will be referred to herein as single loop racks. By

contrast, rack embodiments such as shown in Fig. 15A rotate linked-together loops 310, 320 formed from similar holders, whereas the rack embodiment of Fig. 15C rotates a loop 310 formed from linked-together holders 150 or 150' that can each retain two or more objects. Racks such as shown in Figs. 15A and 15C will be referred to herein as multi-loop racks.

**The paragraph which begins on page 8, line 29 has been amended as follows:**

In the embodiments described in the parent application, the internal surfaces of fingers 34 and 35 preferably included projections 35a and 34b (see Figs. 4 and 5). These arms and projections promoted receiving the left and right edges of a container 18, which would be releasably and frictionally retained until selected and removed from holder 32 by a user. Projections [34a] 35a and 34a are sized and positioned to interlock with mating slots or depressions (e.g., slot 31a in Fig. 4A) that are formed on the sides of container 18. Containers 18 typically are manufactured with two such slots on the left and right side of the jewel case (a total of four slots). The slots are formed to produce interior tabs that can retain printed information concerning the CD within the jewel case. In the present invention, mating between holder arm projections 35a, 34a and jewel case slots 31a (and corresponding 31b, not shown) can provide a positive coupling between containers and holders. The somewhat flexible nature of fingers 34 and 35, holder 32 preferably having been formed from ABS type plastic, further contributes to the retention of a CD jewel case.

**The paragraph which begins on page 13, line 9 has been amended as follows:**

Turning now to Figs. 14A and 14B, improved jewel case holders are depicted. Holder 32 in Fig. 14A in many ways is similar to holder 32 as depicted in Figs. 4 and 5, except that side projections 35a and [34b]

34a are replaced with projecting bumps or ridges 100A and 100B. Ridges 100A and 100B are formed on the inner, jewel case facing, surface of upper and lower holder walls 120A and 120B. These ridges preferably are injection molded when holder 32 is fabricated and frictionally retain the projecting ridge that is formed on the perimeter of CD jewel cases. The ridges may be formed as a series of separate bump-like projections, and/or as continuous projections. In Fig. 14A, ridges 100A and 100B are setback a distance D1 of about 0.275" from the inner surface of rear wall 130 of the holder, have a length L1 of about 0.3" and have a maximum vertical projection of about 0.07". In cross-section the ridges have a somewhat half-circle smoothed profile. Ridges 100A, 100B need not be formed as continuous projections, and may instead be formed as one or more separate bump-like projections. Regardless of their specific configuration, projections or ridges 100A and 100B help frictionally retain a jewel case within holder 32, even if the jewel case is inserted upside down. By contrast, the configuration of Fig. 4 required jewel cases to be properly aligned because recesses 31a with which holder projections 35a and [35b] 34a mated were formed only on the edges of the jewel case closest to the hinged jewel case lid. Other ridge configurations and/or positions could instead be used, and indeed projections or ridges 100A, 100B could be replaced with strips of rubber or other material to help frictionally retain a jewel case inserted into holder 32.

**The paragraph which begins on page 18, line 1 has been amended as follows:**

Central base portion 360 preferably includes a compartment for batteries B1 that can power motor 28, and optionally includes electronics 390 associated with an optional barcode scanning system 400 disposed in a clip-on type lamp unit 410 that includes a light source 420, for example at least one light emitting diode (LED). Lamp unit 410 attaches to a circular region at the upper portion of vertical support member 330, which region can be similar in size to the region to which control 37 is attached at the upper portion of vertical

support member 340. Electrical contacts 430 in the base portion of unit 410 mate with contacts 440 in vertical support member 330. If no lamp unit is provided, the otherwise open circular region in the upper portion of member 330 can be plugged with a circular knob, similar to control 37. Electrical wiring or traces interconnecting lamp unit 410 to power source B1 (or external power provided via input jack J1) and, if present, to circuit 390 are disposed in or on the interior surface of vertical support member 330.

**The paragraph which begins on page 18, line 28 has been amended as follows:**

An optional handheld remote unit 460 includes keys 470, a power source 480 and an output transducer [90] 490, and permits a user to cause electronics 390 (or at least a portion of the electronics) to recognize a user-desired barcode 450 when scanned by unit 410. Unit 460 can transmit desired barcode information to rack 400 using, without limitation, ultra sound, radio frequency, infra red transmissions. An appropriate sensor (SENS) detects the transmitted information, which is coupled to electronics 390. A user desiring to select a certain CD, a particular song, or perhaps a particular digital data base, or a software routine can input on remote unit 460 the appropriate identifying information, which is then transmitted to the sensor (SENS). As the two belts 310, 320 rotate, scan codes carried by any jewel cases within scan range of unit 410 are identified by unit 410, and electronics 390 can cause motor 28 to cease rotation. If desired, cessation of motor rotation can be intentionally delayed by electronics 390, to permit belt rotation to bring the desired jewel case to a more vertically upright disposition, e.g., case 18' in Fig. 15A. Remote unit 460 may be a modified or unmodified generic control such as used on TVs and VCRs, or it may be an IR or Bluetooth-compliant PDA or laptop or desktop computer. Rather than manually key in the barcode per se, preferably remote unit 460 can transmit an abbreviated code that represents the full barcode of the desired CD.

**The paragraph which begins on page 23, line 1 has been amended as follows:**

Although the various preferred embodiments of a rack depicts jewel cases 18 containing a CD 15, as indicated in the upper most portion of Fig. 150C, [an object] a container 18 can retain other than a CD. Thus, [object] container 18 may contain, for example, a baseball trading card 15' or other memorabilia. Understandably a rack intended to retain baseball trading cards could utilize holders 32, 150, 150' that preferably were scaled down in size to retain objects smaller than CD jewel boxes.

## APPENDIX B

As required by 37 C.F.R. §1.121(b)(ii), marked-up copies of the claims amended in this Response are provided below with insertions underlined and deletions bracketed. Claims 47-58 have been added. Claims 27-36 have been cancelled.

15. (Twice amended) [An injection-moldable] A holder usable to create a continuous loop formed by matingly interlocking adjacent such holders, the holder comprising:

first and second walls retained a spaced-apart distance from each other [sufficient] and sufficiently adapted to admit and frictionally retain at least a portion of at least one object to be retained by said holder;

a first holder-engaging mechanism; and

a second holder-engaging mechanism; and

wherein said first holder-engaging mechanism on said holder is disposed to matingly interlock with [the] a second holder-engaging mechanism on a second said holder, [when desired to form said loop; and

] and said second holder-engaging mechanism on said holder is disposed to matingly interlock with the first holder-engaging mechanism on a third said holder [when desired] to form said loop, such that said second holder-engaging mechanism of each said holder is shaped and adapted to be seated in a groove between adjacent teeth on a sprocket.;

wherein said holder is injection-molded as a one-piece component.]

16. (Once Amended) The holder of claim 15, further including at least one projecting member

[formed on an object-facing surface of] located on at least one of said first and second walls[, said member disposed to aid in retaining] retain said object.

20. (Once Amended) The holder of claim 15, wherein said holder is sized to retain two [compact disk jewel cases in a side-by-side configuration.] objects such that both objects are aligned in the same horizontal plane.

21. (Once Amended) The holder of claim 20, further including:

a rib member joined to a portion of each of said first and second walls to bifurcate an object retaining space between said first and second walls into space to retain at least a portion of a [compact disk jewel case] first object and into space to retain at least a portion of a second object [compact disk jewel case]; and

a projecting member formed on at least one of said first and second walls on a surfacing facing a retained first said [compact disk jewel case] object and facing a retained second said [compact disk jewel case] object.

37. (Once Amended) A [one-piece holder] adapted to matingly interlock with adjacent such holders to create a continuous loop of said holders, the holder comprising:

a base having an inward and outward surface, said inward surface having a male coupling mechanism and a female coupling mechanism said male and female coupling mechanisms extending inwardly from said inward surface;

first and second members spaced-apart from each other a distance sufficient to admit and frictionally retain at least a portion of a compact [disk] disc (CD) jewel case to be retained by said



holder, and said first and second member extending outwardly from said outward surface; and

said male and female coupling mechanism [means for] matingly interlock[ing] adjacent holders to each other to form said continuous loop[, said means for matingly interlocking being an integral portion of said holder].